

The opinion in support of the decision entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES K. SANKEY, LAWRENCE R. YEAGER  
and RONALD M. MARSILIO

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Appeal No. 2002-1099  
Application No. 09/208,119

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ON BRIEF

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Before COHEN, ABRAMS and STAAB, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 18-27, 29-31 and 33-35, all the claims currently pending in the application.

Appellants' invention pertains to a security container for recorded media that can only be opened with a specific key, and more particularly to a security container that includes features that prevent the spine of the container from being securely grasped and

torn open. Specifically, the container is configured such that the spine connecting the container base to the container lid does not extend beyond the sidewall of the base when the lid is closed such that there is no exposed portion of the spine that can be grasped for forcibly tearing open the container. A further understanding of the invention can be derived from a reading of claims 18, 25 and 30, the independent claims on appeal, which appear in Appendix A to appellants' main brief.

The references relied upon by the examiner in the final rejection are:

Hehn	4,184,594	Jan. 22, 1980
Hagiwara et al (Hagiwara)	4,593,814	June 10, 1986
Koizumi	5,690,224	Nov. 25, 1997
Nakasuji	5,823,341	Oct. 20, 1998

The following rejections under 35 U.S.C. § 103(a) are before us for review:<sup>1</sup>

(1) claims 18, 19, 24, 30, 31, 33 and 35, rejected as being unpatentable over Hehn in view of Koizumi and Nakasuji;

(2) claims 20-23, 25-27, 29 and 34, rejected as being unpatentable over Hehn in view of Koizumi and Nakasuji, and further in view of Hagiwara; and

(3) claims 18-23, 25-27, 29, 33 and 34, rejected as being unpatentable over Hagiwara in view of Koizumi and Nakasuji.

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<sup>1</sup>The examiner's answer also inadvertently listed canceled claim 32 among the claims rejected in rejection (1).

Reference is made to appellants' main and reply briefs (Paper Nos. 20 and 23) and to the examiner's answer (Paper No. 22) for the respective positions of appellants and the examiner regarding the merits of these rejections. Appellants also rely on the declaration of Ron Marsilio (Paper No. 13)<sup>2</sup> as evidence of nonobviousness.

### Discussion

#### Rejection (1)

Looking first at rejection (1), Hehn, the examiner's primary reference in this rejection, pertains to a video cassette storage container for securely holding and containing two different sizes of video cassettes. Hehn's container comprises a base having a bottom wall 2 and a sidewall 3-5, a spine 24 connected to the bottom wall with a first living hinge, and a lid 14 having flange portions 15-17 connected to the spine with a second living hinge. Tabs 22 on the lid are received in receiving members 8 on the base to hold the lid in the closed position relative to the base. A pair of upstanding, transversely extending flanges 31, 32 are integrally molded with the inner surface of the spine adjacent the outer ends thereof. These flanges are in alignment with flange portions 16, 17 of the lid. As explained at column 6, lines 28-35, flanges 31, 32 of the spine and flange portions

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<sup>2</sup>Paper No. 13 is incorrectly captioned as an affidavit.

15-17 of the lid are in close proximity with and inboard of the sidewall 3-5 when the lid is closed to provide a relatively dust-free enclosure.

As conceded by the examiner, Hehn does not meet the limitation of independent claim 18 that the spine does not extend beyond the sidewall when the lid is in the closed position, or the limitation of independent claim 30 calling for a pair of tabs mounted on the spine, disposed inwardly of the end walls when the lid is closed, wherein the tabs are positioned at the ends of the spine with no portion of the spine extending beyond the tabs. The examiner's reliance on Koizumi to overcome these deficiencies is not well founded.<sup>3</sup>

Koizumi is directed to a storage case for a tape cassette. The storage case comprises a main body member 2 and a lid member 4 interconnected by a spine 3. The spine appears to be connected to the main body member and lid member by first and second living hinges. As depicted in Figure 1, the main body member 2 and lid member 4 each have a peripheral sidewall that extends around three edges of a respective member and partially along a fourth edge to a location adjacent an end of the spine, such that the ends of the spine are disposed inwardly of the peripheral side edges of the main body member and lid member.

In proposing to combine Hehn, Koizumi and Nakasuji to reject claims 18, 19, 24, 30, 31, 33 and 35, the examiner contends (answer, page 4) that it would have been

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<sup>3</sup>The examiner also relies on Nakasuji in rejection (1), however, Nakasuji is not applied for a teaching of the limitations in question.

obvious to one of ordinary skill in the art in view of Koizumi to provide a shorter panel for the spine of Hehn, presumably so that the spine of Hehn ends at the tabs 32, "to save material cost" (answer, page 4). There is nothing in the combined teachings of Hehn and Koizumi, however, that would have suggested this proposed modification. More particularly, the examiner has directed us to nothing in either Hehn or Koizumi that suggests or teaches that the spine of Koizumi is shortened relative to the width of the main body member 2 and lid member 4 for any reason whatsoever, much less for the reason proposed by the examiner, i.e., to save on the cost of material. Furthermore, since the sidewalls of the main body member and lid member of Koizumi extend around the side edges of the members, apparently to compensate for the fact that the spine does not extend the full width of said members, it is entirely possible that the sort of construction shown in Koizumi requires the use of more, rather than less, material. In this light, it is evident that the only suggestion to combine Hehn and Koizumi in the manner proposed by the examiner stems from hindsight knowledge impermissibly derived from appellants' disclosure. This constitutes a first reason for reversing the examiner's rejection of claims 18, 19, 24, 30, 31, 33 and 35 as being unpatentable over Hehn in view of Koizumi and Nakasuji.

In addition, the examiner contends that it would have been obvious to provide Hehn's container with a lock mechanism of the type disclosed in Nakasuji. Be that as it may, the resulting container would not comprise at least one set of locking holes

that move substantially perpendicular to the common axis defined by the holes when the lid is *initially moved* from the closed position toward the open position, as called for in claim 18. In this matter, the examiner's observation (answer, page 6) that the holes in the lid of Nakasuji would be substantially perpendicular to the common axis defined by the holes when the lid is moving *halfway from the closed position* does not suffice. This constitutes a second reason for reversing the examiner's rejection of claims 18, 19 and 24 as being unpatentable over Hehn in view of Koizumi and Nakasuji.

#### Rejection (2)

The examiner additionally relies on Hagiwara in this rejection. Hagiwara is directed to a magnetic tape cassette storing case comprising, in pertinent part, a cover 4 having a sidewall that includes outwardly extending flanges (not numbered) at the ends of the sidewall adjacent the hinge 3a. As can be seen upon review of Figures 1 and 2, these flanges do not extend out from the sidewall to the edge of the cover.

The examiner admits that Hehn, the primary reference, does not meet the limitation of claim 20 that the sidewall of the base includes a flange that extends out from the sidewall to the edge of base, or the limitation of independent claim 25 that the sidewall of the base has a flange extending outwardly therefrom such that no portion of the spine extends beyond the flange. Nevertheless, the examiner contends that it would have been obvious further in view of Hagiwara to modify Hehn to account for this deficiency.

Hagiwara does not cure the fundamental deficiencies of Hehn, Koizumi and Nakasuji with respect to the limitations of claim 18 that the spine does not extend beyond the sidewall when the lid is in the closed position, or that container comprises at least one set of locking holes that move substantially perpendicular to the common axis defined by the holes when the lid is initially moved from the closed position toward the open position. On this basis alone, the rejection of claims 20-23, which depend either directly or indirectly from base claim 18, cannot be sustained.

Moreover, the examiner's reliance on Hagiwara for a teaching of the flange limitations of claims 20 and 25 noted above also is not well founded. Even if Hehn were to be provided with a flange of the type disclosed by Hagiwara, the resulting modified storage case would not have a flange that extends out from the edge of the sidewall to the edge of the base, as called for in claim 20, or a flange that extends outwardly such that no portion of the spine extends beyond the flange, as called for in claim 25. The examiner's position that it would have been further obvious to extend the flange of the modified Hehn container to the edge of the base "since a change in size is generally recognized as being within the level of ordinary skill in the art" (answer, page 4) is not well founded. First, the proposed extension of the flange of the modified Hehn container involves not merely a change in size, but rather a change in *relative* size of the flange compared to the base and spine of the container. Hence, the examiner reliance on *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) in support of the proposed extension of the flange is improper.

Further, the test for obviousness is not measured in terms of what is “within the level of ordinary skill in the art.” Instead, there must be some teaching, suggestion or inference in the prior art as a whole or some knowledge generally available to one of ordinary skill in the art that would have led one of ordinary skill in the art to make the modification needed to arrive at the claimed subject matter. *See, inter alia, In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). In the present case, the examiner has identified no teaching, suggestion or inference in the applied prior art or knowledge generally available to the ordinarily skilled artisan that would have led said artisan to make the additional modification proposed by the examiner. For this additional reason, the rejection of claims 20-23, 25-27, 29 and 34 as being unpatentable over Hehn in view of Koizumi, Nakasuji, and Hagiwara cannot be sustained.

### Rejection (3)

The examiner’s starting point for this rejection is Hagiwara. The examiner concedes that Hagiwara lacks, among other things, a spine not extending beyond the sidewall when the lid is in the closed position, as set forth in claim 18, or a flange extending out from the sidewall at each end of the sidewall to the edge of the base, as set forth in claims 20, or no portion of the spine extending beyond the flange as set forth in



claim 25. The examiner's position (answer, page 5) that it would have been obvious to provide a shorter panel for the hinge panel of Hagiwara "to save material cost," and/or to extend the flange of Hagiwara to the edge of the base "since a change in size is generally recognized as being within the level of ordinary skill in the art" is not well taken for the reasons explained above. Accordingly, rejection (3) also cannot be sustained.

Since the examiner has failed to establish a *prima facie* case of obviousness with respect to any of the appealed claims, it is not necessary for us to consider appellants' evidence of nonobviousness (i.e., the Marsilio declaration).

Conclusion

Each of the examiner's rejections is reversed.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN  
Administrative Patent Judge

NEAL E. ABRAMS  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

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